

Customer No.: 31561
Application No.: 10/064,454
Docket No.: 8327-US-PA

REMARKS

Present Status of the Application

The Office Action rejected claims 1, 5-6, 8 and 10-11 under 35 U.S.C. 103(a) as being unpatentable over Becker (US 5,379,379) in view of Mills (US 5,497,355) and Pollak (US 6,618,724). The Office Action further rejected claims 2-3 as being unpatentable over Becker in view of Mills, Pollak and Mann (US 5,954,813). The Office Action also rejected claim 4 and 9 as being unpatentable over Becker in view of Mills, Pollak and A.P.A. Applicant respectfully traverses the rejections and states clearly how the application distinguishes from the combination of the citations, and reconsideration of those claims is respectfully requested.

Discussion of Office Action Rejections

First of all, Becker and Mills are not proposed to solve analogous problems. Accordingly, those with ordinary skill in the art can not combine the two citations together for achieving the technique feature disclosed in the present application.

Even the Examiner insists that the citations can be combined together, combination of the citations cannot render the claimed subject matter obvious for the reasons stated below:

The Office Action asserts that Pollak teaches that the characters are compared to detect mismatches before they are combined into strings (Page 3, lines 7-12 of the Office Action). Applicants respectfully disagree.

As pointed out by the Office Action, Pollak discloses that *"Many of these string comparison routines operate by successively comparing characters, bytes or words of the strings*

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in order from the first character, byte or word, of the strings to the last character, byte or word, of the strings." (column 1, lines 62-67). However, it can be found that the **Pollak never teaches anything about combining strings**. In other words, **Pollak only teaches to compare two strings but never teaches to combine anything after the comparison**. Accordingly, the assertion "... by successively comparing the characters, Pollak clearly teaches that these characters (i.e., portions) are compared to detect mismatches before they are combined into strings." made by the Office Action can not be found in Pollak.

"Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious **unless the prior art suggested the desirability of the modification**. Further, In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), "To prevent the use of hindsight based on the invention to defeat patentability of the invention ... the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select the elements from the cited prior art references for **combination in the manner claimed**."

Accordingly, because **none of the citations teaches to do comparison before combination of two strings**, the Office Action should not assert the comparison routine disclosed by Pollak must be combined into other citations such that it takes place before the strings are combined.

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Accordingly, combination of the citations does not render claim 1 obvious because combination of Becker, Mills and Pollak at least does not disclose, teach or suggest the feature of "... wherein said first section read address and said second section read address are compared respectively before they are combined" as claimed in claim 1 for at least the reasons stated above.

Accordingly, combination of Becker, Mills and Pollak does not form the basis for all obviousness rejection on claim 1. Therefore, claim 1 is patentable over Becker in view of Mills and Pollak.

Since claim 1 is patentable over Becker in view of Mills and Pollak, claims 5-6, which depend on claim 1 and are rejected basing on the same prior arts, are patentable as a matter of law.

Claim 8 is patentable over Becker in view of Mills and Pollak at least because the reason stated for claim 1 since both claims contains features that can be distinguished from those prior arts and is rejected basing on the same prior arts and reasons, respectively.

Since claim 8 is patentable over Becker in view of Mills and Pollak, claim 10, which depends on claim 8 and is rejected basing on the same prior arts, are patentable as a matter of law.

Claim 2 is patentable over Becker in view of Mills and Pollak, and further in view of Mann. Combination of Becker, Mills and Pollak does not form the basis for all obviousness rejection on claim 1 as set forth above. Further, even combined with Mann, the cited prior arts still do not disclose the same feature of "...wherein said first section read address and said second section read address are compared respectively before they are combined" as

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claimed in claim 1, which is depended by claim 2. Therefore, combinations of Becker, Mills, Pollak and Mann does not form the basis for all obviousness on claim 1.

In other words, claim 1 is patentable over Becker in view of Mills, Pollak and Mann. Claim 2 is patentable over Becker in view of Mills and Pollak, and further in view of Mann as a matter of law at least because the reasons set forth above. For at least the same reason, claim 3 is found patentable over Becker in view of Mills and Pollak, and further in view of Mann as a matter of law.

Claim 4 is patentable over Becker in view of Mills and Pollak, and further in view of APA because claim 1 is patentable over Becker in view of Mills and Pollak as set forth above. Further, even combined with Mann, the cited prior arts still do not disclose the same feature of **"...wherein said first section read address and said second section read address are compared respectively before they are combined"** as claimed in claim 1, either. Accordingly, combination of Becker, Mills, Pollak and APA does not form the basis for all obviousness rejection on claim 1. Therefore, claim 4 is patentable over Becker, Mills, Pollak and APA as a matter of law.

Claim 9 is patentable over Becker in view of Mills and Pollak, and further in view of APA for the same reason as stated for claim 4. Therefore, claim 9 is patentable as a matter of law at least because the combination of those prior arts does not provide a rational reason to reject claim 8, which is depended by claim 9.

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For at least the foregoing reasons, Applicant respectfully submits that independent claims 1 and 8 patently define over the prior art reference, and should be allowed. For at least the same reasons, dependent claims 2-6 and 9-11 patently define over the prior art as well.

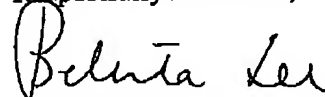
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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-6 and 8-11 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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